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EXAMINER

AFTERGUT, JEFF H

ART UNIT PAPER NUMBER

1733

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/706,649

Applicant(s)

PARK, IL-SOOK

Examiner

Jeff H. Aftergut

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 3-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1 and 2 in the reply filed on 8-21-06 is acknowledged. The traversal is on the ground(s) that the claimed groups are so similar that no serious search burden is present and the examiner should be required to examine both in the same application in order to more economically expedite the application. This is not found persuasive because as previously noted there are mandatory searches in different classes of invention for the article of manufacture and the method by which the same is made rendering a serious burden upon the examiner. Additionally, the applicant is advised that there is an examination burden associated with the examination of both the article and method of making the article in the same application. Namely, the method by which the article is made is of no consequence to whether the article is patentable or not. As such, it is believed in earnest that the restriction is proper and is therefore maintained.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 3-8 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 8-21-06.

***Drawings***

3. Figures 8 and 9 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid

abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: There is no mention in the specification of item "15" found in Figures 7, 10, and 11. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in view of PCT WO 01/19601.

It was known at the time the invention was made to extrude a single component for making a vacuum hose which had a single wire disposed in the profile member as depicted with respect to Figures 8 and 9 however the processing for forming the vacuum hose from such an assembly required the use of multiple extruders which each formed one of the profile members having the wire embedded portion, the flat portion and the curved portion. The admitted prior art failed to teach that those skilled in the art at the time the invention was made would have employed a single extruder to form a profiled member which was of a shape which included multiple flat portions and multiple curved portions which did not require as much adhesive to assemble in the winding operation wherein subsequent to the extrusion operation the profile was subjected to molding in a sizing mold to provide the profile with the desired shape prior to winding the same into a hollow vacuum tube.

The reference to PCT '601 suggested that those skilled in the art at the time the invention was made would have formed a vacuum hose by extrusion of a profiled strip followed by winding of the same into a hose where the edges of the strip were attached to one another. The reference suggested that those skilled in the art would have extruded the profile to have two flat portions 26 and 27 which were associated with two curved portions 28 and 29. One viewing the same would have understood that rather than forming individual profiled portions in the admitted prior art, it would have been

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understood that several profiles could be formed simultaneously in a single extruder (with the wires fed into the extruder). Subsequent to extruding the profile component in PCT '601, the profiled component was reshaped with one or several profiled rolls which corresponded to the shape of the finished work piece. The reference to PCT '601 suggested that the profiled member exiting the extruder was of a larger size than the desired final size and that subsequent to extrusion it was shaped with the profiled rollers (a sizing mold) to the final desired shape. Note that after formation of the profiled member it was wound and the edges adhered with a glue string 23 from nozzle 24 in order to form the vacuum hose. It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a sizing mold in the extrusion line for forming an extruded profile for a vacuum hose wherein one extruded the profile to a larger size than that desired at the exit of the die and subsequently reshaped the same to the desired final profile in a sizing mold as taught by PCT WO 01/19601 in the process of making a vacuum hose by extruding a profile and adhering the edges of the same in a winding operation wherein the profile included an electrical wire therein as taught by the admitted prior art.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In claim 1, lines 8-9, the claim recites "molding a multi-extrusion molding band in the size of the finished state at a sizing mold", however there is no nexus between this molding at a sizing mold and the extruded "primary extrusion molding band" having a size larger than a size at a finished state. It is suggested that the language on lines 8-9 be changed to –molding the primary extrusion molding band (13) into a multi-extrusion molding band (10) having the size of the finished state at a sizing mold--.

***Allowable Subject Matter***

9. Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

None of the prior art of record taught or suggested that one skilled in the art would have formed a profile having a thinner semicircular portion than the connector portions prior to shaping in the primary extrusion to a finished state.

***Conclusion***


10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Japanese Patent 10-14843 suggested the formation of a profiled member including electrical wires therein which was used in the formation of a suction hose and formed via an extrusion operation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff H. Aftergut whose telephone number is 571-272-1212. The examiner can normally be reached on Monday-Friday 7:15-345 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jeff H. Aftergut  
Primary Examiner  
Art Unit 1733

JHA  
September 26, 2006